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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,575	03/31/2004	Prashant Anil Tatake	135070-1	8915

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EXAMINER

SHIPPEN, MICHAEL L

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/815,575	Applicant(s) TATAKE, ET AL	
	Examiner MICHAEL L. SHIPPEN	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/31/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102¹

Claims 1, 3-6, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 2,663,735. See Example 3 wherein the molar ratio of phenol to acetone appears to about 1.1:1, which is greater than 1:1 as claimed. As to the claims that require a specified amount of acetol, this appears to be inherent in the prior process since the reaction step recited in the claims is the same as the prior art reaction step, see *In re Sussman*, 60 USPQ 538 and *In re Fahrni*, 100 USPQ 388. If there is a critical feature of applicants' invention that distinguishes it from the prior art process, such is not recited in the claims. As to the claims that recite the presence of water, this reads on essentially no water and/or the water that would inherently be present in the reagents such as the sulfuric acid.

Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,414,151. Note the examples. The fact the there may be differences in the method of preparation of the phenol is of no moment since the bisphenol compound is the same regardless of the method of preparation of a starting material.

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,648,561. See Example 6. The fact the there may be differences in the method of

¹ The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1621

preparation of the bisphenol is of no moment since the carbonate compound is the same regardless of the method of preparation of a starting material.

Claim Rejections - 35 USC § 103²

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 2,663,735. The reference is applied as above. Besides the example, the reference teaches that various reaction parameters may be varied to obtain similar results. It is well within the skill of the artisan to operate within the parameters suggested by the disclosure of the reference and carry out the prior art process with the expectation that one will obtain the results taught in the reference. Moreover, the optimization of reaction conditions for a particular reaction system to optimize a result (such as to maximize the yield of a desired product) is well within the skill of the artisan through routine experimentation, *In re Aller*, 105 USPQ 233.

² The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim Rejections - 35 USC § 112³

Claims 11 and 12 are rejected under 35 USC 112, first and second paragraphs. There is no description or enablement of such compounds in the specification as filed. Nor do the claims set forth the actual compounds contemplated. The claim language is not descriptive of the actual nature of the compounds claimed. The term "bisphenol" only suggest that the compound contains two phenol groups but fails to identify the compound as a whole. The term "polycarbonate" only suggests that the compound contains multiple carbonate groups but fails to identify the compound as a whole.

Claims 11 and 12 are rejected under 35 USC 112, fourth paragraph, as failing to further limit the parent claims. There is no basis in claim 1 for a bisphenol compound and there is no basis in claim 11 for a polycarbonate compound.

³ The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 112 that form the basis for the rejections under this section made in this Office action:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.


Art Unit: 1621

Claim Objections

Applicant is advised that should claim 3 or 10 be found allowable, the other claim will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(571) 272-0647**. The Examiner's normal tour of duty is 7:30 AM to 4:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(571) 272-1600**. The official group FAX machine number is **703-872-9306**.

MShippen
September 27, 2004


MICHAEL L. SHIPPEN
PRIMARY EXAMINER
ART UNIT 1621